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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 20551 7590 08/21/2007 THORPE NORTH & WESTERN, LLP. 8180 SOUTH 700 EAST, SUITE 350 SANDY, UT 84070 | | | EXAMINER HOWELL, DANIEL W | |
| | | | ART UNIT 3722 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/066,392

Applicant(s)

SPERRY, MARIETTA V.

Examiner

Daniel W. Howell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 15-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moor et al (6,431,779). Moor et al discloses in Fig. 4, an organizer comprising: a closed position (Fig. 2) and an expanded position (Fig. 4); an expanding plurality of pockets for holding sheets (Col. 3, lines 34 and 35); and wherein the organizer has a front wall (14) and a rear wall (12) which are transparent such that a color aspect of contents of the organizer can be visually appreciated (Col. 3, lines 23-33); and wherein the organizer is made out of polypropylene (Col. 1, lines 61 and 62). However, Moor et al does not disclose wherein the pockets are configured substantially square for holding 12 x 12 sheets of paper. It would have been an obvious matter of design choice to construct the pockets of desired dimensions to hold any desirable sized sheets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. It would have been obvious to modify Moor et al's organizer to a size which can accommodate a variety of unfolded sheet sizes, since such a change would not alter the function of the pocket for holding sheets of paper, and it would be based upon the item the end user would want to place in the pocket.

3. Claims 1-6, 11-14, 17, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatano et al (5,741,028) in view of Hatano et al's prior art. Hatano et al discloses in Fig. 1-3, an expandable transparent organizer comprising: a closed position (Fig. 2)

and an open position (Fig. 3); a plurality of first expanding pockets (30) for holding sheets; and wherein the organizer has a front wall (11) and a rear wall (14), which are configured for holding and organizing contents; a second pocket (seen in Fig. 1), which can be seen when the organizer is in a closed position (since cover walls (15) are transparent). The method of organizing materials is inherently taught by Hatano et al as modified by Hatano's prior art. However, Hatano et al does not disclose pockets for holding 12 x 12 unfolded sheets of paper; and wherein the organizer is configured such that at least an aspect of contents can be visually appreciated (transparent) through a wall of the container. Hatano et al's prior art (as indicated in Col. 1, lines 10-12), discloses a folder wherein the walls of the container can be transparent and made out of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hatano et al's organizer to include transparent cover walls as taught by Hatano et al's prior art for the purpose of visually appreciating the color aspect of the contents.

In regards to **Claim 1**, it would have been an obvious matter of design choice to construct the pockets to hold any desirable sized sheets of paper, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to modify Hatano et al's organizer to a size that can accommodate a variety of unfolded sheet sizes of paper, including a substantially square size each having dimensions larger than 12" X 12", since such a change would not alter the function of the pocket for holding sheets of paper, and it would be based upon the item the end user would want to place in the pocket.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the walls out of any desirable plastic component such as polypropylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to modify Hatano et al organizer with walls constructed out of any desirable plastic component, since applicant has not disclosed that a particular plastic component is critical to his invention, and that the organizer walls would work equally as well with any transparent component.

Regarding claim 11, and noting the second pocket on the front cover 11 in figure 1, it is considered to have been obvious to have provided a plurality of such storage pockets, i.e. "a third pocket," in order to increase the number of items which may be stored, as this is merely a duplication of existing items.

The limitation in claim 11 that the items are for use during "scrapbooking" does not provide an actual structural limitation of the device, and Hatano et al is also capable of holding scrapbooking items.

4. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatano et al in view of Hatano's prior art and further in view of Lee et al. Hatano et al as modified by Hatano et al's prior art discloses an organizer comprising all the elements as claimed in Claim 1, and as set forth above. Hatano et al further discloses that the second pocket (seen in Fig. 1) that can be seen when the organizer is in a closed position (since cover walls are transparent). However, Hatano et al does not disclose: a second and third see-through pocket configured to hold data storage media and computer disks. Lee et al discloses in Fig. 1 and 2, discloses a second pocket

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28 for holding a data storage medium/label and a third pocket 26 for holding a computer disk (column 4, lines 42-46 and column 5, lines 57-63), wherein the walls (cover) of the pockets are transparent/see through. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hatano et al's and Hatano et al's prior art organizer to include a second and a third pocket as taught by Lee et al for the purpose of holding additional information as well as labeling the organizer.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hatano et al in view of Hatano's prior art and Lee et al, and further in view of Shannon (4,784,508). Hatano et al as modified by Hatano's prior art and Lee et al discloses an organizer comprising all the elements as disclosed in Claim 11, and as set forth above. However, Hatano et al does not disclose a transparent substrate (pocket wall) being color tinted. Shannon discloses in Fig. 1, a transparent plastic substrate (in this case tab (16), as disclosed in Col 2, lines 50-55), which can be color tinted. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hatano et al's organizer with a color tinted transparent substrate as taught by Shannon for indexing purposes.

6. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Applicant's arguments filed 9-26-06 have been fully considered but they are not persuasive. Much of Applicant's arguments are directed to the 12" X 12" square paper used for scrapbooking and the importance of having an organizer capable of holding such a size. It is well within the abilities of one of ordinary skill in the art to provide a proper size of storage

device for whatever item is to be protected. For instance, in the late 1970s and early 1980s, the conventional size of hobby photographs was about 3" by 5". Over time, the preferences of consumers changed and hobby photographs grew to a 4" by 6" size. Makers of photo organizers recognized this shift of preference by the consumer, and they made the slots for reception of photographs in photo albums/organizers larger in order to receive those larger 4" by 6" photographs. The issue in the current application is the same: if the consumer has a desire to store a square paper page having a size of 12" X 12", then one skilled in the art will know to provide the devices of Moor et al and Hatano et al with dimensions appropriate to hold those items that the scrapbookers want to save. The fact that Moor et al or Hatano et al show a rectangular shape does not hinder this thought process of one of average skill in the art. If the consumer **needs** a square shape, then one of average skill in the art will know to **make** a device having a square shape. Moving from a rectangular shape to a square shape simply doesn't take a very difficult thought process. On pages 10 and 15 of the arguments, Applicant has argued that there is no suggestion in Moor et al to eliminate the binder. The Examiner has never proposed eliminating the binder, and there is nothing in any of the claims which precludes the existence of the binder.

Regarding Hatano et al, Applicant has argued that Hatano et al is a "plastic box" that "is not disclosed as or shown as expandable." Lines 1-34 of column 1 give some background of devices such as Hatano et al. This section discloses that such folders are generally put into a drawer to form a row of folders, and the folders are pulled out of the drawers as needed. Many people who have worked in offices or stored papers for income taxes in their homes are familiar with such

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folders which have been filled with so much material that they bow outward and expand. As such, it is considered to be inherent that the device of Hatano et al is expandable to some degree.

On page 13, Applicant submits an argument that only the front plate of the prior art device is transparent. With all due respect, it appears that Applicant is not interpreting this section full context. There isn't enough here to draw the conclusion that only the front plate is transparent. Lines 10+ of column 1 are written such that it appears that both the rear plate and front plate are usually made of transparent material. Regarding Applicant's arguments on page 14, the envelopes/pockets 30 of Hatano et al are clearly capable of storing paper. On pages 14-15, Applicant has argued that modifying Hatano et al would eliminate the display feature of Hatano et al, but this simply isn't correct.

On page 16, regarding the second pocket of Hatano et al, Applicant argues "we do not know if this is really a pocket." It is quite apparent that this structure is a pocket, and as discussed above it would be obvious to make the cover of Hatano et al transparent.

It will be noted that claims 15 and 16 have been objected to as being allowable, as they would not be obvious. However, regarding claim 7, note that a label is a "data storage medium." The printed words on the label would be the "data." Claim 7 is not so specific as to be solely directed to any sort of computer disc.

The declarations have been considered by the Examiner. However, it is noted that none of the declaration are directed to any of the prior art references used above, and as such do not provide arguments of why the rejections should fall.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Monica Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.



Daniel W. Howell
Primary Examiner
Art Unit 3722